Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/16/09 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
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> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 10 and 11 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Valdez (US 4,685,477). Valdez discloses cigar or cigarette holder capable of receiving a cigar or cigarette and for filtering smoke generated from the cigar or cigarette. The holder has three chambers. The first chamber defined by the space between a perforated tubular member, concentrically situated around a perforated inner tubular member, and the inner tubular member. The first chamber is substantially filled with a filter material. The second and third chambers are within the inner tubular member, substantially coaxially aligned and separated by a wall having an aperture to transfer ash from the second chamber to the third chamber. The claimed non-combustible tubular member is deemed as element 25, which as noted in Col. 3, lines 10 made be made of porcelain, a known ceramic, which is non-combustible. Element 25 as shown in figure 3 encases the tobacco charge which is deemed as the tobacco rod 14. In regards to claim 11, the perforation 26 provide for the claimed porosity.

As noted by Valdez, the plurality of air intake spaces, perforations 26, is useful for enabling the ember end of the cigar or cigarette to burn. As the smoker puffs or draws on the primary smoke filter end of the cigar or cigarette, air may be drawn into the second and third chambers through the air intake spaces to enable the ember to burn. In this manner, sufficient air is provided for burning of the tobacco to generate smoke. Valdez teaches that varying the size and/or number of the air intake spaces to control the rate at which the ember end of the cigar or cigarette burns is possible. In this manner, the cigar or cigarette may be made to burn slower and therefore last

longer than if smoked without the use of Valdez device. Thus the perforations 26, as noted by Valdez, reduces the free-burning rate of the burning tobacco in order to increase the number of puffs from the burning tobacco charge as instantly claimed by applicant.

In view that the tubular member 25 has a certain porosity as determined by the size and number of perforations 26, the sidestream smoke is minimized when compared to a cigarette not enclosed by the tubular member 25 of Valdez.

Moreover, in view that the Valdez provides the claimed structural limitations as recited in device claims 10 and 11, it would be obvious to a person of ordinary skill in the art as noted above to have met the claimed functions.

Alternatively, Valdez inherently provides the claimed features recited in claims 10-11 by encapsulating a cigarette with glass material having a specified number of perforations and perforation size. The encapsulation of the cigarette inherently minimizes the amount of sidestream smoke and at the same time reduce the free burn rate of the cigarette, due to less air being supplied to the burning cigarette, in order to increase the number of puffs from the burning tobacco charge as instantly claimed.

In regards to the added limitation defining the tubular element as “having a proximal tip end and open distal end”, it is noted that there are no reference points given. Meaning the proximal end can be considered the end adjacent to the burning end of the cigarette or filter end of the cigarette. Thus, the proximal end is deemed as the end adjacent to the burning end of the cigarette and the distal end is deemed as the end adjacent to the filter of the cigarette which as shown in figure 3 is open in order

to allow the insertion of the cigarette. Furthermore, the both ends of Vadez may be considered as open because it allows the insertion of a cigarette or the flow of air into the tubular element.

It is additionally noted that the response to argument section provided in the final rejection dated 7/16/09 is incorporated herein.

Claim 10 and 11 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 06-052497 ('497). '497 discloses cigar or cigarette holder capable of receiving a cigar or cigarette The holder comprises a glass stowage element 2, deemed to be a ceramic material[1], which encases an effective amount of tobacco charge as shown in figures 1 and 2. The storage ceramic element comprises of fine pores 8, thus allowing for the reduction of the claimed side-stream smoke and restricting the inflow of air to thus reduce the free-burn rate of the burning tobacco.

In view that the tubular member 2 has a porosity as determined by the size and number of pores 8, the sidestream smoke is minimized when compared to a cigarette not enclosed by the tubular member of '497. Moreover, in view that the '497 provides the claimed structural limitations as recited in device claims 10 and 11, it would be obvious to a person of ordinary skill in the art as noted above to have met the claimed functions.

Alternatively, '497 inherently provides the claimed features recited in claims 10-11 by encapsulating a cigarette with glass material having a specified number of

perforations and perforation size. The encapsulation of the cigarette inherently minimizes the amount of sidestream smoke while reducing the free burn rate of the cigarette due to less air being supplied to the burning cigarette.

In regards to the added limitation defining the tubular element as "having a proximal tip end and open distal end", it is noted that there are no reference points given. Meaning the proximal end can be considered the end adjacent to the burning end of the cigarette or filter end of the cigarette. Thus, the proximal end is deemed as the end adjacent to the burning end of the cigarette and the distal end is deemed as the end adjacent to the filter of the cigarette which as shown in figure 3 is open in order to allow the insertion of the cigarette. Furthermore, the both ends of '497 may be considered as open because it allows the insertion of a cigarette or the flow of air into the tubular element.

It is additionally noted that the response to argument section provided in the final rejection dated 7/16/09 is incorporated herein.

Response to Arguments

Applicant's arguments filed 6/30/09 have been fully considered but they are not persuasive.

In response to the arguments presented against Valdez noting that it fails to provide an open end. It is noted that the limitation "having a proximal tip end and open distal end", provides no reference point. Meaning the proximal end can be considered the end adjacent to the burning end of the cigarette or filter end of the cigarette. Thus,

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[1] The term ceramic is a generic term encompassing materials such as glass, enamel, concrete, cement,

the proximal end is deemed as the end adjacent to the burning end of the cigarette and the distal end is deemed as the end adjacent to the filter of the cigarette which as shown in figure 3 is open in order to allow the insertion of the cigarette. Furthermore, both ends of Valdez may be considered as open because it allows the insertion of a cigarette or the flow of air into the tubular element. Hence, the word “open” is deemed as being met by Valdez because it allows air and the language of the claim has no reference point to determine where are the distal and proximal ends.

As previously noted in the final rejection, claim only requires a tubular element having a predetermined number of pores which would **restrict** the flow of air causing a reduction in the free burn rate of the cigarette. It was then noted in the final rejection that it is reasonable to conclude that the cigarette in the JP 497 tubular element would have a reduce free-burn rate when compared to a cigarette not placed in the tubular element of JP 497 because JP ‘497’s tubular element would obstructed the free flow of air reaching the burning cigarette[2]. Consequently, less air reaching the cigarette (when compared to the air present for a cigarette not enclosed by a tubular element) would reduce the free burn rate of the cigarette.

Applicant points out that in JP 497 the "oxygen is supplied through venting holes opened all over the surface of the encasing section 2, so the cigarette can stay lit while installed in the encasing section 2". Applicant then concludes that one skilled in the art would not interpret this recitation as restricting the inflow of air to thus reduce the free-

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pottery, brick, porcelain, and chinaware.

[2] It is noted for the record that applicant has not addressed this assertion. In view that it has not been rebutted, is applicant agreeing to the assertion?

burn rate of the burning tobacco. However, applicant's conclusion is deemed as unreasonable when a closer reading of '497 is made.

As noted in paragraph 15, "Similarly, nicotine and tar contained in the secondhand smoke are also removed when the smoke passes through the wall of the holder [encasing section 2]. Thus, with the use of the smoking pipe of this invention, not only the smoker but also the people around him or her can avoid inhaling toxic nicotine substances." This fact combined with applicant's citation leads to the reasonable conclusion that the encasing 2 allows sufficient air to allow the cigarette to remain lighted (but in now way means that "restriction" of air will not occur) but at the same time allows for obstruction of the second hand smoke in order to effectuate filtering to remove tar and nicotine when the second handsmoke is coming out of the encasing. Thus, in order to allow for filtering of tar and nicotine, it is reasonable to assume that some "restriction" of the second hand smoke/air coming out from the encasing would occur. Thus, if some restriction of air occurs to allow filtering of second hand smoke coming out of the encasing, then some restriction of air would also occur when the air comes in to the encasing 2. Consequently this restriction of air then leads to lower air supplied to the cigarette thus reducing the burn rate; especially when compared to a cigarette not enclosed by encasing having pores of .05μm.

Applicant points out that the encasing may have a pore size of .05μm. It is unclear how a person of ordinary skill in the art would conclude that despite the fact of having an encasing with such small pore sizes air is not restricted.

In conclusion a fair reading of '497 is that it is sufficient porous to allow for the cigarette to remain lighted but it provides restriction to the air coming out (and thus coming in) in order to filter out tar and nicotine. This restriction of air would thus reduce the free burn rate of the cigarette because less air reaches the burning cigarette when you compare a cigarette that has not encasing with pore sizes of .05μm.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS LOPEZ whose telephone number is (571)272-1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos Lopez/

Primary Examiner
Art Unit 1791